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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,526	12/05/2001	Richard J. Massey	100390-6370	3441

35745 7590 06/02/2005

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
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NEW YORK, NY 10036

EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/007,526

Applicant(s)

MASSEY ET AL.

Examiner

Mary (Molly) E. Ceperley

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached letter. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 19-41.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached letter.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Mary (Molly) E. Ceperley
Primary Examiner
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1) The information disclosure statement (IDS) filed April 25, 2005 fails to comply with the requirements of 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. The IDS was filed after the January 05, 2005 mailing date of the final rejection (37 CFR 1.97©) thus requiring both the fee set forth in 37 CFR 1.97(d)(2) **and** a statement as required under 37 CFR 1.97(d)(1).

2) The amendment filed May 09, 2005 has not been entered since it does not simplify the issues for appeal.

a) The proposed amendment to claim 19 is not in standard Markush format: "selected from the group consisting of...and a derivative thereof".

b) Claim 26 refers to "said electrochemiluminescence co-reactant", a term which was canceled in currently amended claim 19.

c) Claim 37 fails to recite a step whereby a detectable ECL response could be correlated with the presence/amount of analyte in the sample (final rejection, paragraph **5)e**).

A newly presented amendment of the same scope as the May 09, 2005 amendment, which also corrects the above-noted problems, would be entered.

3) Presuming that an appropriate amendment would be submitted which addresses the deficiencies noted in paragraph **2)** above, the rejection under 35 USC 112, second paragraph, as set forth in paragraph **5)b)** of the January 05, 2005 final rejection is maintained. Although applicants state that a configuration wherein the ECL label is attached inside the nanotube is not intended (May 09, 2005 Remarks, page 10, paragraph (b)), the claims are inclusive of this configuration. Applicants have not addressed the examiner's statement that the claims also include a configuration wherein the ECL label is covalently attached directly to the enzyme co-factor.

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4) The submission of an appropriate amendment which addresses the deficiencies noted in paragraph **2)c)** above would overcome the rejection of claims 37 and 38 under 35 USC 112, second paragraph, for the reason stated in paragraph **5)e)** of the January 05, 2005 final rejection.

5) Presuming that an appropriate amendment would be submitted which addresses the deficiencies noted in paragraph **2)** above, the claims remain rejected for obviousness-type double patenting as being unpatentable over the corresponding claims of US patent no. 5,866,434 for the reason stated in paragraph **6)** of the January 05, 2005 final rejection. Applicants have not rebutted the examiner's statement that the compositions of the instant claims are included in the nanotube compositions of the patent. Compare the composition of **instant claim 19** comprised of "a carbon nanotube", "an enzyme co-factor" attached to the nanotube and "an electrochemiluminescent label" attached to the nanotube and the composition of **claim 18 of the patent** comprised of "a graphitic nanotube" linked to "an electrochemiluminescent label" and "an enzyme cofactor".

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

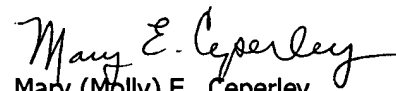
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 31, 2005


Mary (Molly) E. Ceperley
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